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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,762	06/01/2001	Sean M. McCullough	VIGN 1230-1	7625

44654 7590 09/21/2006

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EXAMINER

STORK, KYLE R

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/681,762	Applicant(s) MCCULLOUGH, SEAN M.	
	Examiner Kyle R. Stork	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 26-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This non-final office action is in response to the request for continued examination and the amendment filed 11 July 2006.
2. Claims 1-24 and 26-32 are pending. Claim 25 has been cancelled by the amendment. Claims 26-32 have been added by the amendment. Claims 1, 12, 23-24, and 26 are independent claims. The rejection of claims 1-24 under 35 USC 103 has been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 5, 8-9, 12, 16, 19-20, 23-24, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Park et al. (US 6295061, filed 30 November 1999, hereafter Park).

As per independent claim 1, Park discloses a method of modifying a target document comprising:

- Accessing a first file comprising code renderable to produce a target document (Figure 6, item 20), a second file comprising a metadata element (Figure 7, item

21), and a third file comprising a rendering instruction (Figure 7, item 28), wherein code comprises a target element (column 7, line 34- column 8, line 4: Here, the first file is an HTML page. Further, the metadata information (item 21), which can contain text representing an explanation of data (goods/brand name) and the rendering instructions (item 28) can be stored in separate files)

- Locating the target element to which the metadata element applies and by processing at least a portion of the code of the first file (column 8, lines 19-24: Here, the first file containing target elements is analyzed to incorporate the metadata file)
- Transforming the metadata element into a rendered element by using the rendering instructions (column 9, lines 22-37: Here, the script language contained within the rendering instructions is processed to overlap the metadata with the target element)
- Displaying the rendered element in conjunction with the target element (column 7, lines 49-57: Here, the data is to be displayed on a monitor via a web browser)

As per dependent claim 5, Park discloses wherein the rendered element overlies the target element (column 9, lines 22-37; column 10, lines 47-60: Here, elements are overlaid upon each other through the <LAYER> tag).

As per dependent claim 8, Park discloses inserting the rendered element into the target document (column 9, lines 22-37).

As per dependent claim 9, Park discloses wherein:

- When after inserting, the rendered element overlays the target element (column 9, lines 22-37)
- The target element can be seen at least partially though the rendered element (column 9, lines 22-37)

As per independent claims 12, 24, and 26, the applicant discloses the limitations substantially similar to those in claim 1. Claims 12 and 26 are similarly rejected.

As per dependent claims 16 and 19-20, the applicant discloses the limitations substantially similar to those in claims 5 and 8-9 respectively. Claims 16 and 19-20 are similarly rejected.

As per independent claim 23, Park discloses a method of modifying a target document comprising:

- Accessing a metadata element in a first file, wherein the metadata element specifies a corresponding target element (Figure 7, item 21; column 8, lines 19-24)
- Searching code in a second file corresponding to a target document for the target element corresponding to the metadata element (Figure 6, item 20; column 8, lines 19-24)
- Displaying the target document, wherein displaying the target document includes displaying the metadata element and the target element in conjunction with one another according to a rendering instruction (column 7, lines 49-57; column 9, lines 22-37)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4, 6-7, 10-11, 13-15, 17-18, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park, and further in view of Lerner et al. (US 6859909, filed 7 March 2000, hereafter Lerner).

As per dependent claim 2, Park discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Park fails to specifically disclose calculating screen coordinates relative to the target document where the rendered element is to be displayed. However, Lerner discloses the method further comprising calculating screen coordinates relative to the target document where the rendered element is to be displayed (column 6, line 64- column 8, line 20; column 8, lines 13-36: Here, the user is allowed to ink annotations over a document. This in turn causes the document to become frozen to prevent reflowing of the target elements (WBD). However, the annotation maintains the position of the inking relative to the target document). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lerner with Park, since it would have allowed a user to obtain rendered data in the intended position.

As per dependent claim 3, Park and Lerner disclose the limitations similar to those in claim 2, and the same rejection is incorporated herein. Lerner further discloses

the method further comprising displaying the rendered element in conjunction with the target element at the screen coordinates (Figures 8, 10, 15-16, and 18-19; column 6, line 64- column 8, line 20). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lerner and Park, since it would have allowed a user to obtain rendered data in the intended position.

As per dependent claim 4, Park discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Park fails to specifically disclose wherein locating further comprises matching a term within the metadata element with a corresponding term within the rendering instruction. Lerner discloses the method wherein locating further comprises matching a term within the metadata element with a corresponding term within the rendering instruction (column 9, line 58-column 10, line 36). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lerner with Park, since it would have allowed a user to determine the correct element to render.

As per dependent claim 6, Park discloses the limitations similar to those in claim 5, and the same rejection is incorporated herein. Park fails to specifically disclose wherein the rendered element includes a row or column of icons. Lerner discloses the limitations similar to those in claim 5, and the same rejection is incorporated herein. Lerner further discloses the method wherein the rendered element includes a row or column of icons (Figure 8, item 820 and 825: Here, the rendered annotation element contains a row of icons). It would have been obvious to one of ordinary skill in the art at

the time of the applicant's invention to have combined Lerner with Park, since it would have allowed a user to view rendered elements in an organized manner.

As per dependent claim 7, Park discloses the limitations similar to those in claim 5, and the same rejection is incorporated herein. Park fails to specifically disclose wherein the target element includes numerical information; the rendered element includes a depiction of the numerical information; and the depiction includes a representation of the numerical information in at least two dimensions. Lerner discloses the limitations similar to those in claim 5, and the same rejection is incorporated herein. Lerner further discloses the method wherein:

- The target element includes numerical information (Figure 5, item 530; column 5, lines 19-21: Here, a target element contains a time/date stamp that specifies a time/date an annotation was created for the WBD)
- The rendered element includes a depiction of the numerical information (Figure 16: Here, a date is listed along the bottom of each annotated WBD)
- The depiction includes a representation of the numerical information in at least two dimensions (Figure 16)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lerner with Park, since it would have allowed a user to receive numerical data as a target element.

As per dependent claim 10, Park discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Park fails to specifically disclose wherein a tag within the metadata element includes a locating information to locate the

target element within the target document. Lerner discloses the method wherein a tag within the metadata element includes a locating information to locate the target element within the target document (column 6, line 64- column 8, line 20; column 8, lines 13-36; column 9, line 58-column 10, line 36). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lerner and Park, since it would have allowed a user to locate the appropriate target element for metadata.

As per dependent claim 11, Park discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Park fails to specifically disclose wherein the metadata element includes an identifier for the target document. Lerner discloses the method wherein the metadata element includes an identifier for the target document (Figure 5). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Lerner and Park, since it would have allowed a user to locate the appropriate target element for metadata.

As per dependent claims 13-15, 17-18, and 21-22, the applicant discloses the limitations substantially similar to those in claims 2-4, 6-7, and 10-11. Claims 13-15, 17-18, and 21-22 are similarly rejected.

7. Claims 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park, and further in view of Sponheim et al. (US 7058944, filed 25 April 2000, hereafter Sponheim).

As per dependent claim 27, Park discloses the limitations similar to those in claim 26, and the same rejection is incorporated herein. Park fails to specifically disclose wherein the location of the second file is specified in the third file. However, Sponheim discloses wherein the location of necessary files are specified in other files (Figures 1 and 5; column 4, line 53- column 5, line 6). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Sponheim with Park, since it would have allowed a user to specify the location of Internet resources stored at a remote location.

As per dependent claim 28, Park and Sponheim disclose the limitations similar to those in claim 27, and the same rejection is incorporated herein. Park further discloses wherein the metadata element specifies the location of the one or more corresponding target elements in the code of the second file (column 8, lines 19-24).

As per dependent claim 29, Park and Sponheim disclose the limitations similar to those in claim 28, and the same rejection is incorporated herein. Park further discloses wherein processing the portion of code comprises parsing the code (column 8, lines 19-24; column 6, lines 7-24).

As per dependent claim 30, Park and Sponheim disclose the limitations similar to those in claim 29, and the same rejection is incorporated herein. Park discloses wherein the code comprises a set of tagged elements and the set of tagged elements comprises the one or more target elements (column 10, lines 47-60).

As per dependent claim 31, Park and Sponheim discloses the limitations similar to those in claim 30, and the same rejection is incorporated herein. Park discloses

wherein the metadata element identifies the one or more target elements (column 7, line 58- column 8, line 4; column 8, line 59- column 9, line 37).

As per dependent claim 32, Park and Sponheim disclose the limitations similar to those in claim 31, and the same rejection is incorporated herein. Park further discloses wherein the rendering instruction comprises program code (Figure 7).

Response to Arguments

8. Applicant's arguments with respect to claims 1-24 and 26-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kyle R Stork
Patent Examiner
Art Unit 2178

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